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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,261	02/06/2004	Michael J. Shelton	200209031-1	8670

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HEWLETT PACKARD COMPANY  
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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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RODRIGUEZ, LENNIN R

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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04/04/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/774,261	<b>Applicant(s)</b> SHELTON ET AL.	
	<b>Examiner</b> LENNIN R. RODRIGUEZ	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-17 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-17 is/are allowed.
- 6) ☒ Claim(s) 1, 9 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 2-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/2004 and 7/14/2005</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species 5, including claims 1-6, 9-17 and 40-42 in the reply filed on 01/03/2008 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 9 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 6,141,111).

(1) regarding claim 1:

Kato '111 discloses a method of printing user-selected ones of a collection of images, comprising:

printing a plurality of proof sheets (column 5, lines 1-4, where a proof sheets are being printed) each having a thumbnail representation of at least some of the images (column 5, lines 38-41, where the reduced image is being interpreted as a thumbnail image), and at least one user-markable field indicative of at least one corresponding image when marked (column 5. lines 40-41, where the check portion is the user-markable field);

optically scanning a plurality of user-marked ones of the proof sheets to detect marked ones of the at least one user-markable field (column 6, lines 21-25, where Step S5 is performing the scanning of the proof sheet);

processing the marked ones of the fields to determine at least one selected image associated with each scanned proof sheet (column 6, lines 26-33, where each proof sheet is checked for the markings in the sheet); and

printing the at least one selected image after the plurality of user-marked proof sheets have been scanned (column 6, lines 38-45).

(2) regarding claim 9:

Kato '111 further discloses wherein at least some individual ones of the plurality of proof sheets are indicative of a same subset of the images (column 4, lines 56-67 and column 5, lines 1-4).

(3) regarding claim 40:

Kato '111 further discloses a method of printing subsets of images selected from a collection of images, comprising:

identifying the images in the collection (column 4, lines 53-67 and column 5, lines 1-4, where images are being selected from a collection in a digital camera);

printing at least one proof set (column 5, lines 1-4, where a proof sheets are being printed), each proof set including a proof sheet having a thumbnail representation of each image (column 5, lines 38-41, where the reduced image is being interpreted as a thumbnail image) and at least one user-markable field associated with at least one of

the thumbnail representations (column 5, lines 40-41, where the check portion is the user-markable field);

distributing each proof set to a user, each user marking desired ones of the fields so as to define one of the subsets (column 5, lines 30-46, where the user makes the selection because the proof sheets were distributed);

retrieving the user-marked proof sets (column 6, lines 21-25, where after a user makes the desired selections the proof sheets are collected and processed);

optically scanning the proof sheets to detect the user-marked fields (column 6, lines 21-25, where Step S5 is performing the scanning of the proof sheet);

processing the user-marked fields to determine the images in the subsets (column 6, lines 26-33, where each proof sheet is checked for the markings in the sheet);

collating the subsets so as to determine, for each image, a corresponding number of copies to be printed according to a particular set of print characteristics (column 6, lines 34-45, where the selected number of copies determined by the user are read and used for printing); and

printing the corresponding number of copies of each image according to the corresponding particular set of print characteristics (column 6, lines 38-45).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Hicks (US 5,359,387).

(1) regarding claim 41:

Kato '111 discloses all the subject matter as described above except printing a summary sheet indicative of the images in each individual subset; and

distributing the printed copies of the images to the users in accordance with the summary sheet.

However, Hicks '387 teaches printing a summary sheet indicative of the images in each individual subset (10 in Fig. 1 and column 4, lines 27-30); and

distributing the printed copies of the images to the users in accordance with the summary sheet (11 in Fig. 1 and column 4, lines 36-38).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made printing a summary sheet indicative of the images in each individual subset; and distributing the printed copies of the images to the users in accordance with the summary sheet as taught by Hicks '387 in the system of Kato '111. With this, it is possible to produce a plurality of negatives, a plurality of proof prints are made from the negatives on a single sheet of photographic proof paper, and an order form for ordering final photographic prints is printed on the single sheet of proof paper (column 2, lines 4-8).

6. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Squilla et al. (US 6,623,528).

(1) regarding claim 42:

Kato '111 discloses all the subject matter as described above except wherein the printing comprises: rendering the image once to form a rendered image; and printing the rendered image the corresponding number of times.

However, Squilla '528 teaches wherein the printing comprises: rendering the image once to form a rendered image (column 4, lines 59-64); and printing the rendered image the corresponding number of times (column 4, lines 59-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the printing comprises: rendering the image once to form a rendered image; and printing the rendered image the corresponding number of times as taught by Squilla '528 in the system of Kato '111. With this consumers can create photocollages and photo albums in a manner that is as simple as ordering prints (column 1, lines 41-44).

#### ***Allowable Subject Matter***

7. Claims 10-17 are allowed.

8. The following is an examiner's statement of reasons for allowance:

(1) Claim 10 is directed to a method of printing user-selected ones of a collection of images. Claim 10 identify the uniquely distinct features of "determining identical ones of

the print specifications; summing the print counts associated with all of the identical ones to form a total print count T; and printing T copies of the selected image associated with the identical ones in accordance with the associated print characteristics". The closest prior art Kato (US 6,141,111) in Fig. 4A teaches at the prescribed positions of an extra-copy designation sheet 100, there are arranged a user ID input portion 101, a bin output selection portion 104, an E-mail deliver selection portion 105, an image index portion 102 and an extra-copy check portion 103. The bin output selection portion 104 and the E-mail delivery selection portion 105 are the portions to select the bin output to the bin 18 or the E-mail delivery to the image display 24 and other image printers 27 through 29 by way of the network 16. When such selection is desired, an operator himself writes a mark on the sheet. At this time, it is also possible to select both of them and if so, a mark is entered for both of the bin output and the E-mail delivery; either singularly or in combination with other cited references fails to anticipate or render the above underlined limitations obvious (when used with all the claimed limitations).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



10. The following is a statement of reasons for the indication of allowable subject matter:

In claim 2 the limitations “wherein the processing includes determining a print count associated with each selected image, and wherein the printing includes: determining identical ones of the selected images; summing the print counts of the identical selected images to form a total print count T; and printing T copies of one of the identical selected images” are not taught by any of the cited prior art either singularly or in combination and therefore the references fail to anticipate or render the subject matter. Since claims 3-6 depend on claim 2, they are not anticipated at least for the same reasons.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Edwards (US 2004/0174562) discloses a system and method for enabling a user to select for additional processing a digital image, utilizing an apparatus containing a printer and a scanner, is disclosed, which may comprise: an order form generator adapted to generate a proof-less order form having at least one image order selection designation area, each of the at least one image order selection designation areas printed on the proof-less order form spatially accompanying one of a plurality of image identifiers, each image identifier corresponding to an image that is available for designation as being selected, without the reproduction of any graphical representation of the respective image itself on the order form; and an order processing apparatus

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adapted to scan the proof-less order form and interpret image order selection information associated with each of the plurality of image identifiers and to generate image selection information for further image processing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625

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Lennin Rodriguez  
3/30/08